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09/821,344	03/29/2001	Junichi Ito	OOCL-55 (6HS-01S0104)	5341
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STRAUB & POKOTYLO 620 TINTON AVENUE BLDG. B, 2ND FLOOR TINTON FALLS, NJ 07724			ZURITA, JAMES H	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/821,344

Applicant(s)

ITO, JUNICHI

Examiner

James H Zurita

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 6 and 11-16 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Group I (claim 1) in the reply filed on 5 November 2004 is acknowledged.

Applicant cancelled claims 7-10, 13 and amended claims 1-3. Because of applicant's amendment, claims 2-5 will be examined with Group I.

Claims 6, 11-12 remain subject of the Restriction Requirement, which applicant traverses on the ground(s) that said claims are in the same class and subclass as Group I, and therefore would place no serious burden on the Examiner. Applicant's arguments are not found persuasive for grounds explained in the original restriction requirement, said grounds found to be still applicable.

The requirement is still deemed proper and is therefore made FINAL.

### ***Priority***

Receipt is acknowledged of papers filed on 29 March 2001 purporting to comply with the requirements of 35 U.S.C. 119(a)-(d) and they have been placed of record in the file.

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4).

For example, reference character “3” has been used to designate Fig. 1, CD-ROM, Fig. 8, custom made cards, Fig. 9, custom-made sheets. Similarly, CD-ROM is reference 3 and 84 (Fig. 8).

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action.

The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

The following claims are objected to because of informalities:

Claim 1 refers to a “information preparing program” while other claims refer to a “information preparation program”. This appears to be a typographical error. Claim 1 will be interpreted to refer to “information preparation program.”

In Claims 2 and 3, “ the supplier...” lacks antecedent basis.

Claim 5 refers to “...**the** camera operation control program...” that is not otherwise mentioned.

Claim 5 reads "...said...include at least one of **the** information ..., information..., information..." This appears to be a typographical error and will be interpreted to read, "...said...include at least one of information ..., information..., information..."

Claims 2, 3 refer to a supplier, which appears to correspond to the manufacturer, and not the retailer, shown in the drawings.

Claim 3, step 1, for recording the information on a predetermined recording medium and step 2, transmitting the information by sending the medium from the buyer to the supplier does not further limit claims 1 and 2, since claim 2 includes a step for transmitting the information by way of a telecommunications line.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 and dependent claims refer to modifying the specifications of a product, but fail to mention modifying the product itself according to a buyer's changes to the specifications:

[first step] for a buyer to prepare [information] for ***modifying the specifications of a product*** on the basis of [a program] made available to the buyer by buying the product and adapted to ***modify the specifications*** so as to satisfy his or her demand; and

a [second step] for ***modifying the specifications of the product*** on the basis of said [information] prepared in said [first step].

For purposes of this examination, the Examiner will interpret claim 1, second step to read as performing the modifications of a particular specific product according to information entered by a buyer.

Claim 4 requires a second program for evaluating the expense incurred by the modification of the product, but the product has never been modified. The Buyer has only *prepared* information that is intended to serve as the basis for modifying the specifications of the particular specific product. Further, since the modifications are done by the supplier, any expense valuation is incurred in the future and after the product has been sent to the supplier, the actual expense incurred is outside the scope of claim 4. For purposes of this examination, claim 4 will be interpreted to refer to anticipated expense incurred by actual modification of the product.

Claim 1 appears to require that the program be

- [a] made available to the buyer by buying the product and
- [b] adapted to modify the specifications so as to satisfy his or her demand; and

It is not clear whether applicant intended to claim patentable limitations and distinction from these phrases. These limitations are implied but not positively recited and fall outside the metes and bounds of claim 1. As such, the limitations carry little or no patentable weight.

### ***Claim Rejections - 35 USC §101***

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requires of this title.

Claims 1-5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable

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subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source **human** language (e.g., Russian) into a target **human** language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.



The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present application, it is noted that certain claims appear to recite technology, but the technology is involved in a trivial manner. Other claims contain nonfunctional descriptive material. For example, these labels provide little patentable moment to the various claim limitations:

"...information preparing/preparation step..." claims 1, 2.

"...specification modifying step..." claim 1.

"...information preparing program..." claims 1, 4.

"...specifications modifying information..." claim 2.

"...transmission step..." claim 2.

"...information recording step..." claim 4.

"...program for evaluating the expense incurred by the modification to the product..." claim 4.

"...camera operation control program..." claim 5.

A program is a public notice<sup>1</sup> and does not necessarily refer to computer executable instructions embedded in tangible medium. The various steps in the claims can be performed using paper and pencil. The transmission step may be performed via the US Postal Service network, as contemplated in several embodiments.

To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as incorporating a computer network or electronic network into the transmission step, for example.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (US 6,167,383) in view of Parulski (US 6,836,617).

**As per claim 1**, Henson discloses systems and method steps for a customer to modify the specifications for an electronic product according to a customer's demand.

Henson discloses one or more programs that permit a customer to:

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<sup>1</sup> Definition of *program*, MERRIAM WEBSTER Collegiate Dictionary.

prepare information (for example, Fig. 4 and various configurable items that can be selected by a customer) to customize his computer. See also Fig. 1 and references to configurator program.

Modifying the product on the basis of the information prepared in the previous step. See, for example, at least Col. 2, line 5-Col. 3, line 54, which disclose that a computer has been modified according to information obtained from various user interfaces. The various programs are made available over the Internet to customers that buy products such as computers. The programs accept customer modifications to specifications to satisfy the customer's demands.

As per claim 1, Henson **does not** specifically refer to a program that is made available to a buyer by buying a product. However, the differences do not alter the information preparing step and specification modifying step. It would have been obvious to one of ordinary skill in the art at the time the invention was made to make such a program available to a consumer at any time. One of ordinary skill in the art at the time the invention was made would have been motivated to make such a program available to a consumer at any time for the obvious reason that customers often like to comparison-shop, perhaps to determine the optimum configuration of a product obtainable within a customer's budget.

**As per claim 2**, Henson discloses step(s) for transmitting the prepared information from a customer to the supplier by way of a telecommunication line. See, for example, at least Fig. 2 and references to the Internet.

**As per claim 2**, Henson also discloses that modifying the product is performed by the supplier (on-line store). See, for example, at least Col. 2, lines 36-53.

**As per claim 3**, Henson discloses step(s) for recording the prepared information on a predetermined recording medium. See, for example, at least Fig. 2, item 40, and Fig. 11 and related text, which describe storage devices that store prepared information.

Henson discloses that the information is transmitted from a customer to the online store. See, for example, at least Fig. 2 and references to the Internet.

**As per claim 3**, Henson **does not** specifically that information is transmitted by sending the recording medium that stores the information from the customer to the supplier. Henson discloses serving various business segments, including government and corporate clients, whose personnel may login to alter limited specifications. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Henson to disclose that information may be transmitted by sending recording medium that stores information from a customer to a supplier. One of ordinary skill in the art at the time the invention was made would have been motivated to modify Henson to disclose that information may be transmitted by sending recording medium that stores information from a customer to a supplier for the obvious reason that such a feature would require a single transmission of information, as opposed to multiple transmissions by a single customer, perhaps one for each employee.

**As per claim 4**, Henson discloses program(s) that allow a customer to evaluate the expense involved by modification of his product. For example, see Fig. 1 and references to pricing, and references to *update price* button in Fig. 3B, and related text.

***As per claim 5***, While Henson discloses that a customer may modify the specifications for an electronic product according to a customer's demand, Henson ***does not*** specifically disclose that a customer may modify specifications for (a) painting and printing an outer surface of a camera, (b) profile of a camera, and (c) the operating control program of a camera.

Parulski discloses customizing electronic products such as cameras according to a customer's demand. See, for example, at least Fig. 11 and related text.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Henson and Parulski to disclose for (a) painting and printing an outer surface of a camera, (b) profile of a camera, and (c) the operating control program of a camera.

One of ordinary skill in the art at the time the invention was made would have been motivated to combine Henson and Parulski to disclose for (a) painting and printing an outer surface of a camera, (b) profile of a camera, and (c) the operating control program of a camera for the obvious reason that mass customization of items such as cameras, permits use of mass production lines yet allow for increased sales by permitting personalization of a camera to create a unique birthday gift, for example.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


Prabhu et al., US-PGPUB 2001/0030695, Customizing a Digital Camera for a Plurality of Users.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James H Zurita whose telephone number is 703-605-4966. The examiner can normally be reached on 8a-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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21 January 2005.

  
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